REMARKS/ARGUMENTS

Applicant appreciates the Examiner granting applicant's attorneys a telephone interview on April 25, 2006. Applicant submits herewith an interview summary form in accordance with M.P.E.P. §713.04.

As noted in applicant's previous responses, applicant assumes that the drawings submitted are acceptable for examination purposes. As such time as the applicant is notified that there is patentable subject matter in the present application, formal drawings will be supplied.

Claims 1-3, 8 and 10 have been amended. The amendment to claim 1 substitutes the term, "substantially automatically," for the term, "semi-automatically." The remaining amendments make minor corrections to obvious typographical errors. The amendments to the claims are not intended to modify the scope of the claims.

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 1 is rejected under 35 U.S.C. §112, second paragraph on the grounds that the word "criteria" is not defined by the claims, and the words "semi-automatically" and "substantially automatically" are similarly not defined by the claims. Applicant respectfully traverses this rejection.

The Court of Appeals for the Federal Circuit has held that claim language, such as use of the term, "substantially automatically," can "accommodate minor variations that may be appropriate to secure the invention." See, for example, Verve LLC v. Crane Cams Inc., 65 USPQ2D 1051, 1054, U.S. Court of Appeals (Fed. Cir. 2002), quoting Pall Corp. v. Micron Separations, Inc., 36 USPQ2D 1225, 1229 (Fed. Cir. 1995). Applicant maintains that the term, "substantially automatically," is a descriptive term that is commonly used in patent claims and avoids a "strict ... boundary to [a] specified parameter." Verve LLC v. Crane Cams Inc. at 1054. One skilled in the art would understand that substantially automatically means, generally, it is overwhelmingly more likely that a process or feature of the invention will occur without or with minimal manual input from a user.

In the Office Action, at page 3, first full paragraph, the Examiner states that, "[f]or examination purposes the word ... 'substantially automatically' will be treated as a search criteria being entered each time for each separate item/merchandise by an individual such as a business

owner." Applicant respectfully but strenuously disagrees with this overly narrow and restrictive construction. As noted in applicant's written description, for example, at page 14, lines 25 - page 15, line 7, merchandise can be added or removed "automatically, when [the website constructor] detects" one or more predefined conditions, such as when a vendor has changed merchandise characteristics. Therefore, the term, "substantially automatically," should not be interpreted as requiring an individual entering item/merchandise search criteria each time a search is made. Reconsideration is respectfully requested.

With respect to the term, "criteria," applicant respectfully submits that the specification is replete with the use of "criteria," and that "selection criteria" relates to merchandise selection. As explained by example at page 7, lines 1-19 in the written description of applicant's application, such criteria can be one or more of category, sub-category, manufacturer, vendor, promotions, and starting and ending dates. One skilled in the art would be able to determine that "selection criteria" as used in the claims means such factors to select merchandise. Therefore, applicant maintains that use of the term, "selection criteria" does not render claim 1 indefinite, under 35 U.S.C. §112. See, for example, GMIS Inc v. Health Payment Review, Inc., 34 USPQ2d 1389 (E.D.PA, 1995) (holding that use of the claim term "non-medical criteria" is not indefinite).

Moreover, a search of the U.S. Patent and Trademark Office Internet web site uncovered over 10,500 issued patents that include the term "criteria" or "criterion" in one or more claims. Further, a search of the U.S. Patent and Trademark Office Internet web site revealed 105 issued patents that include the term, "substantially automatically" or "substantially automatic." With respect to the term, "substantially automatically," applicant respectfully submits that "substantially automatically" means, generally, that it is overwhelmingly more likely that a process or feature of the invention will occur without or with minimal manual input from a user.

The above demonstrates conclusively that the terms, "criteria" and "substantially automatically," are commonly used in patent claims, effectively define and secure the metes and bounds of applicant's invention, and do not render claims indefinite under 35 U.S.C. §112, second paragraph. Accordingly, the Examiner's noted interpretation of the term, "criteria," as a "criteria" by the user for a standard on which a judgement or decision is based is incorrect. Claim 1 recites that "selection criteria" is established by "a selection criteria sub-system." The

narrow interpretation of "criteria" as limited to a user employing a standard on which a judgement or decision is based is not consistent with applicant's claim 1.

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bernardo et al. ("Bernardo," U.S. Patent No. 6,684,369) in view of Saroja Girishankar ("Catalog," "Build the e-commerce catalog"). Applicant respectfully traverses this rejection.

Applicant's amended claim 1 defines a "website constructor" that includes a plurality of modules, including a "selection criteria module," a "website organization module," a "graphic design module," a "merchandise selection module," a "merchandise information downloading module" and a "website builder." The "website organization module" and "graphic design module," respectively, define a "look and feel" and create "at least one website layout and features setup" for a website constructed by the website constructor. Moreover, the "selection criteria module" establishes "criteria for merchandise selection" and the "merchandise selection module" selects "merchandise offered for sale on the website constructed by the website constructor" that "matches the selection criteria" and is "based on merchandise made available by a plurality of vendors[.]" The "merchandise information downloading module" downloads "merchandise information" from "a plurality of vendors of merchandise[.]" The merchandise information defines "merchandise offered for sale on the website constructed by the website constructor that has been selected by the merchandise selector module[.]" Thus, a single website constructor comprising the selection criteria module, the website organization module, the graphic design module, the merchandise selection module, the merchandise information downloading module and the website builder, operates to build a website based on criteria and conditions set up thereby. Applicant respectfully submits that, for the reasons set forth below, the combination of elements defined in Applicant's claim 1 is not taught or suggested by Bernardo, Catalog, or both references combined.

Bernardo describes a fairly typical prior art web site creation tool that essentially applies pre-defined HTML templates to enable a user to build internet web sites (see Abstract). The user is prompted to select features and options desired for the web site and to supply information corresponding to the selected features, and the tool builds the web site from the pre-stored HTML templates and supplied data from the user.

As noted by the Examiner, Bernardo is silent with respect to applicant's claim 1

"selection criteria [module]", "merchandise selection [module]", and "merchandise information downloading [module]". Accordingly, applicant respectfully disagrees with the Examiner that Bernardo teaches applicant's claim 1 "website builder" because claim 1 defines that the "website builder" builds a website based on the criteria and conditions that have been setup by the "selection criteria module," the "website organization module," the "graphic design module," the "merchandise selection module" and the "merchandise information downloading module" (i.e., the "foregoing modules"). Bernardo does not teach or suggest these features, and thus cannot teach or suggest applicant's claim 1 "website builder."

Catalog is cited for providing elements of applicant's claim 1 that the Examiner believes are missing from the teachings of Bernardo. In particular, Catalog is cited for applicant's "selection criteria [module]," "merchandise selection [module]," and "merchandise information downloading [module]," all of which the Examiner concludes are included in a "website constructor" taught by Catalog. Applicant respectfully disagrees.

Catalog describes the evolution of e-procurement and comparison shopping systems that incorporate uniform Extensible Markup Language ("XML") data. Using XML tags, data can be categorized using well-known and used terms, thereby simplifying the process associated with procurement. Catalog describes prior art data management tools, such as described in applicant's written description, particularly in the section devoted to describing the background of the invention.

Applicant respectfully submits that Catalog does not teach or suggest the elements of applicant's claim 1 that are missing from the teachings of Bernardo. Catalog regards receiving data from a plurality of disparate sources and "cleansing" the data in a uniform way, particularly for comparison shopping. Catalog is silent with respect to applicant's claim 1 combined "selection criteria module," "merchandise selection module" and "merchandise information downloading module." Further, Catalog is silent with managing data, and in particular with respect to building a website based on the criteria and conditions that have been setup by applicant's claim 1 modules. Instead, Catalog regards data management, and merely mentions, for example, using the data in an organization's enterprise resource planning system (see, for example, Catalog, page 6, lines 1-3).

Applicant submits that the Examiner's efforts to combine Bernardo with Catalog are based upon hindsight and the teachings of applicant's invention. Without the benefits of applicant's disclosure, one skilled in the art would not be motivated to combine the references as the Examiner has done. Catalog is not directed to website building, but instead to comparison shopping and data management. Bernardo is not directed to data management, but is, instead, directed to editing a web site using a graphical editor.

Even if one were to combine the references as the Examiner has done, applicant's invention still is not taught. The resulting combination is not a website constructor that comprises all of the modules, including a selection criteria module, a website organization module, a graphic design module, a merchandise selection module, a merchandise information downloading module and a website builder. There is no linking component between the prior art web site graphical editor disclosed in Bernardo and the plurality of data managing tools (e.g., directed to on-line catalogs and comparison shopping) disclosed in Catalog. Therefore, the combination of modules defined in applicant's claim 1 is not disclosed in the combined teachings of Bernardo and Catalog.

For the foregoing reasons, applicant respectfully submits that the neither Bernardo nor Catalog, taken alone or in combination, teach or suggest the features defined in applicant's claim 1.
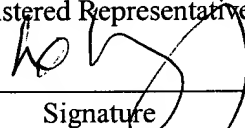
Claims 2-13 depend directly or indirectly from claim 1 and are, therefore, patentable for the same reasons, as well as because of the combination of features in those claims with the features set forth in the claim(s) from which they depend.

Accordingly, it is respectfully submitted that claim 1 and all its dependent claims clearly define over the prior art. Therefore, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on April 26, 2006:

Respectfully submitted,

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Name of applicant, assignee or
Registered Representative

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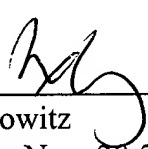Signature

_____April 26, 2006_____
Date of Signature

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